



1634

Customer No. 22,852

Attorney Docket No. 08888.0101-02

In re Application of:

Pascale BRIAND *et al.*

Application No.: 09/986,797

Filed: November 13, 2001

For: RECOMBINANT ADENOVIRUSES
AND USE THEREOF IN GENE
THERAPY FOR TREATING EYE
DISEASES

Group Art Unit: 1634

Examiner: Frank Wei Min LU

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

In the Election of Species requirement dated September 9, 2003, the Office requires Applicants to elect a single species from each of the following groups:

- (1) a defective recombinant adenovirus of type Ad-2 (claim 15) or type Ad-5 (claim 16); and
- (2) a defective recombinant adenovirus administered by subretinal injection (claim 22-23) or intravitreal injection (claim 22).

Applicants elect, with traverse, the following species:

- (1) a defective recombinant adenovirus of type type Ad-5 of claim 16; and
- (2) a defective recombinant adenovirus administered by intravitreal injection of claim 22.

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At least claims 14, 16-22, and 24-26 read on the elected species.

Applicants traverse the election of species requirement on the grounds that the Office has not shown that there would be a serious burden to examine all of the claimed species. Applicants submit that it would be not be a serious burden to examine all of the claimed species because all of the claims recite a method comprising administering to at least one eye cell a defective recombinant adenovirus comprising an inserted gene, wherein the inserted gene comprises at least one sequence permitting its expression in the eye cell. Accordingly, Applicants respectfully request that the full scope of the claimed invention be examined in this application without an election requirement. If the Examiner chooses to maintain the election requirement, however, and should the elected species be found allowable, Applicants expect the Office to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the full scope of the patentability thereof, *i.e.*, extending the search to non-elected species, as is the duty of the Office according to 35 U.S.C. § 121 and MPEP § 803.02.

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If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is invited to call Applicants' undersigned representative at 202-408-4128.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 9, 2003

By: 

Charles D. Niebylski
Reg. No. 46,116